

REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the remarks and amendments herewith.

I. THE DOUBLE PATENTING REJECTIONS ARE OVERCOME

Claims 37-72 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6,331,330 ("the '330 patent") in view of EP 0 252 755. Claims 37 and 39-48 were also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 18 and 23-27 of U.S. Patent No. 6,296,910 ("the '910 patent") in view of EP 0 252 755. The rejections are respectfully traversed.

The Terminal Disclaimer filed January 7, 2006 was not accepted as it allegedly failed to disclaim the term of the entire patent to be granted in favor of a disclaimer of particular claims. Applicants disagree with this assertion. A careful review of the January 7, 2006 Terminal Disclaimer indicates that page 1 of the document recited those specific rejections to which the Terminal Disclaimer was responsive. However, the actual Terminal Disclaimer that followed was not so limited to only those specifically rejected claims, but rather disclaimed the terminal portion of the entire patent to be granted. Thus, Applicants respectfully submit that the double patenting rejections ought to have been withdrawn in response to the January 7, 2006 Terminal Disclaimer.

However, in order to advance prosecution, a second Terminal Disclaimer has been provided herewith that does not identify the specific rejections to which the Terminal Disclaimer is responsive. It is believed that such a Terminal Disclaimer should be acceptable, and the Examiner is welcomed to telephone the undersigned directly if it is believed that any formalities in the Terminal Disclaimer need to be corrected.

As entry of the enclosed Terminal Disclaimer renders the double patenting rejections moot, reconsideration and withdrawal of the double-patenting rejections is respectfully requested.

II. THE ART REJECTIONS ARE OVERCOME

Claim 70 was rejected under 35 U.S.C. §102(b) as allegedly being anticipated over Kim *et al.* (U.S. Patent No. 5,344,676). Claim 72 was also rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Spiller (U.S. Patent No. 3,754,975). Claim 71 was additionally rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kim *et al.* The rejections are respectfully traversed.

Initially, Applicants respectfully thank the Examiner for the withdrawal of the rejection to claim 37 and those claims depending therefrom.

Applicants respectfully remind the Examiner that a two-prong inquiry must be satisfied in order for a Section 102 rejection to stand. First, the prior art reference must contain all of the elements of the claimed invention, *see Lewmar Marine Inc. v. Barient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987), and, the single prior art reference must contain an enabling disclosure, *see Chester v. Miller*, 15 U.S.P.Q.2d 1333, 1336 (Fed. Cir. 1990).

Applicants again respectfully submit that the rejections under 35 U.S.C. §102 fail under such tests.

Furthermore, the Examiner respectfully reminded that for a Section 103 rejection to be proper, there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the reference teachings to arrive at the claimed invention. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (BOPAI 1993). Further, the Examiner is respectfully reminded that “obvious to try” is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.” Also, the Examiner is additionally respectfully reminded that for the Section 103 rejection to be proper, **both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants’ disclosure.** *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

The Examiner is also respectfully reminded that MPEP 2143.01 mandates that for a Section 103 rejection, there must be some suggestion or motivation to modify reference

teachings, and, that MPEP 2143.02 further mandates that for a section 103 rejection, there must be a reasonable expectation of success.

Applicants hereby incorporate herein all of the previous arguments against the art rejections based on Kim et al. and Stiller, and respectfully ask for the reconsideration of the Examiner. If it is believed that the rejections should stand, Applicants respectfully request that pending claims 37-69 be considered allowable in view of the enclosed Terminal Disclaimer, such that Applicant may choose to continue pursuing claims 70-72 herein or to do so in a divisional application.

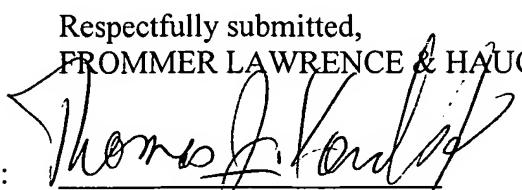
Accordingly, reconsideration and withdrawal of the rejections of the application under 35 U.S.C. §102(b) and §103(a) are respectfully requested.

REQUEST FOR INTERVIEW

If any issue remains as an impediment to allowance, prior to issuance of any paper other than a Notice of Allowance, an interview, is respectfully requested, with the Examiner his supervisor, especially if claims 37-69 are deemed allowable, and, the Examiner is respectfully requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview.

CONCLUSION

In view of the remarks herein and the enclosed Terminal Disclaimer, the application is in condition for allowance. Reconsideration and withdrawal of the rejections of the application, and prompt issuance of a notice of allowance is respectfully requested.

Respectfully submitted,
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